



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/688,098 | 10/17/2003 | David T. Zwolinski | 85939.000298 | 9084 |

23387 7590 08/11/2004

Stephen B. Salai, Esq.
Harter, Secrest & Emery LLP
1600 Bausch & Lomb Place
Rochester, NY 14604-2711

EXAMINER

STRIMBU, GREGORY J

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/688,098 | Applicant(s) ZWOLINSKI ET AL. | |
| | Examiner Gregory J. Strimbu | Art Unit 3634 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 32-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/24/04</u> . | 6) <input type="checkbox"/> Other: ____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-31, drawn to a weatherseal, classified in class 049, subclass 441.
- II. Claims 32-39, drawn to a method of forming a weatherseal, classified in class 049, subclass 506.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make other and materially different product, such as a product that includes a sealing lip.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Brian B. Shaw on August 5, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 3634

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because reference character 30 in figure 2 includes both underlining and a lead line and because of the superfluous lettering in figures 8 and 9. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

Art Unit: 3634

appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

Applicant is advised that should claim 18 be found allowable, claim 31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

Claim 8 is objected to because no dependent claim sets forth a second radius of curvature. Claim 15 is objected to because no previous claims from which claim 15 depends sets forth a first radius of curvature. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as “an inverted” on line 2 of claim 1 render the claims indefinite because it is unclear with respect to what element of the invention the window receiving channel is inverted. Recitations such as “thickness” on line 2 of claim 2 render the claims indefinite because it is unclear to what element of the invention the applicant is referring. In other words, it is unclear what element of the invention has the thickness to which the applicant is referring.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 9, 15, 18, 20-22 and 24-31 are rejected under 35 U.S.C. 102(b) as being anticipated by McManus. McManus discloses a vehicular weatherseal comprising a rigid polymeric backbone 16, 18, 20 and 38 having a flange engaging channel 15 and an inverted window receiving channel (not numbered, but shown between the portions 18 and 38 of the backbone), the window receiving channel defined in cross section by a transitioning leg 18, an exterior leg 38 and a window channel closed end 20

Art Unit: 3634

interconnecting the transition leg and the exterior leg, the window channel closed end being curvilinear since it includes the curved portions at the junctures of the window channel closed end and the transitioning and exterior legs, the flange channel closed end has a constant inner radius of curvature shown at the proximal end of the backbone 16, a sealing lip 56 integrally connected to the backbone, the backbone has at least one inflection point.

It should be noted that McManus discloses a curvilinear window channel closed end and the flange channel closed end since a portion of window channel closed end and the flange channel closed end comprise a curved portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over McManus as applied to claims 1, 5, 9, 15, 18, 20-22 and 24-31 above. McManus is silent concerning an inner radius of curvature to thickness ratio for the window channel closed end.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design

Art Unit: 3634

choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the window channel closed end with an inner radius of curvature to thickness ratio greater than approximately 1 but less than approximately 2.5 to ensure the edge of the window properly seals against the weatherseal.

Claims 1, 6-8, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thies in view of Dover. Thies discloses a vehicular weatherseal comprising a rigid backbone 8, 10 having a flange 1 engaging channel and an inverted window receiving channel (not numbered, but shown in figure 1) the window receiving channel defined in cross section by a transitioning leg 4, an exterior leg 2 and a window channel closed end (not numbered, but shown in figure 1) interconnecting the transition leg and the exterior leg, the window channel closed end being curvilinear and having a constant wall thickness, a linear segment having a length less than the curvilinear segment and a constant radius of curvature, a flange channel closed end having a constant radius of curvature (shown at one of the corners of the flange channel closed end) different from the radius of curvature of the window receiving channel. Thies is silent concerning a polymeric backbone.

However, Dover discloses a weatherseal comprising polymeric backbone 42.

It would have been obvious to one of ordinary skill in the art to provide Thies with a polymeric backbone, as taught by Dover, to reduce the weight of the weatherseal.

Art Unit: 3634

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McManus as applied to claims 1, 5, 9, 15, 18, 20-22 and 24-31 above. McManus is silent concerning the particular inner radius of curvature to thickness ratio for the flange channel closed end.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the flange channel closed end with a radius of curvature to thickness ratio of approximately 1 but less than approximately 2.5 to ensure the edge of the window properly seals against the weatherseal.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McManus as applied to claims 1, 5, 9, 15, 18, 20-22 and 24-31 above, and further in view of Coldre et al. Coldre et al. discloses a weatherseal comprising a flange channel closed end 10, as shown in figure 4, having a varying radius of curvature and a constant wall thickness.

It would have been obvious to one of ordinary skill in the art to provide McManus with a flange channel closed end, as taught by Coldre et al., to more securely grip the flange of the vehicle.

Art Unit: 3634

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over McManus as applied to claims 1, 5, 9, 15, 18, 20-22 and 24-31 above, and further in view of Keeney et al. Keeney et al. disclose a weatherseal comprising an elongation reducing member 72.

It would have been obvious to one of ordinary skill in the art to provide McManus with an elongation reducing member, as taught by Keeney et al., to increase the strength of the weatherseal.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over McManus as applied to claims 1, 5, 9, 15, 18, 20-22 and 24-31 above, and further in view of Dover. Dover discloses a weatherseal having a trim lip 50 connected to a backbone 42.

It would have been obvious to one of ordinary skill in the art to provide McManus with a trip lip, as taught by Dover, to improve the aesthetics of the weatherseal when viewed from inside the vehicle.

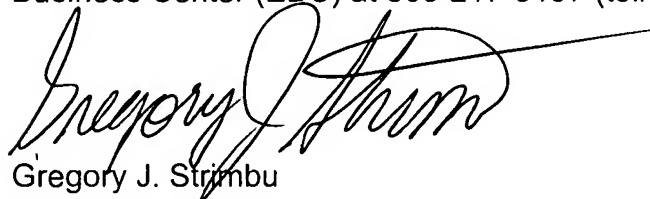
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dupuy, Hattass et al., Larsen et al., Mesnel et al. '258 and '792, Mathellier, Cadiou, Millhouse et al., Onda, Ramsay, Keating et al., European Patent Application Nos. 0 448 270 and 0 367 731 are cited for disclosing a weatherseal comprising at least one of a curved window channel closed end and a flange channel closed end.

Art Unit: 3634

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu
Primary Examiner
Art Unit 3634
August 6, 2004